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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 08/973,293 | 12/01/1997 | ROBERT G. SCHWARTZ | 8001.101/00 | 6722 |

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EXAMINER

COSIMANO, EDWARD R

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 06/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 08/973,293 | SCHWARTZ ET AL. | |
| | Examiner | Art Unit | |
| | Edward R. Cosimano | 3629 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 15 March 2001 .

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 26-28,31-81,130,131,134-183,192-205 and 208-210 is/are pending in the application.
4a) Of the above claim(s) none is/are withdrawn from consideration.

5) Claim(s) 26-28,31-35,130,131,134-138,192-200,205 and 210 is/are allowed.

6) Claim(s) 36-81,139-183,201-204,208 and 209 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 09 July 2001 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 21 & 23. 6) Other: _____

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1. Applicant should note the changes to patent practice and procedure:
 - A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997; and
 - B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000.
2. The finality of the Office Action mailed 09 November 2000 is withdrawn in view of newly found prior art.
3. The drawings are objected to because
 - A) the drawings must show every feature of the invention specified in the claims, therefore, the subject matter of:
 - (1) claims 36-81, 139-183, 201-204, 208 & 209 in regard to the indicia being anything other than a postage indicia since as disclosed in the paragraphs between page 3, line 28, and page 4, line 20, "Still further, we have ... for paying any courier service", applicant intends the word "indicia" or "indicium" as used in these claims to be a postal indicia.
must be shown in the drawings as required by 37 CFR § 1.83(a) or the feature(s) canceled from the claim(s) (note: no new matter should be entered).
- 3.1 A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
- 3.2 Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect may be deferred until after the examiner has considered the proposed drawing correction. Failure to timely submit the proposed drawing correction will result in the abandonment of the application.
4. The disclosure is objected to because of the following informalities:
 - A) the subject matter of :
 - (1) claims 36-81, 139-183, 201-204, 208 & 209 in regard to the indicia being anything other than a postage indicia since as disclosed in the paragraphs between page 3, line 28, and page 4, line 20, "Still further, we have ... for

paying any courier service", applicant intends the word "indicia" or "indicium" as used in these claims to be a postal indicia.

lacks antecedent basis within the specification as required by 37 CFR § 1.75(d1).

Appropriate correction is required.

5. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(g)-1.121(h).

6. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6.1 The specification is objected to under 35 U.S.C. § 112, first paragraph, as:

A) the specification, as originally filed, does not provide support for the invention as now claimed.

6.1.1 In regard to claims 36-81, 139-183, 201-204, 208 & 209, it is noted that applicant's deletion of the word postage before indicia in these claims permits the claim indicia to be almost anything that would perform the recited functions. However, as disclosed in the paragraphs between page 3, line 28, and page 4, line 20, "Still further, we have ... for paying any courier service", applicant intends the word "indicia" or "indicium" as used in the disclosure and the instant claims to be limited to a postal indicia. Hence, the deletion of the word "postage" from these claims provides for the instant claims to provide coverage for invention which are not supported by the original disclosure.

6.1.2. Claims 36-81, 139-183, 201-204, 208 & 209 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

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7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7.1 Claims 36-43, 45, 47-51, 53-59, 61-67, 69, 70, 72-76, 78-81, 139-146, 148, 150-154, 156-162, 164-170, 172, 174-178, 180-183, 208 & 209 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Perazza (5,326,959).

7.1.1 In regard to claims 36-43, 45, 47-51, 53-59, 61-67, 69, 70, 72-76, 78-81, 139-146, 148, 150-154, 156-162, 164-170, 172, 174-178, 180-183, 208 & 209, Perazza ('959) discloses an electronic bill payment system in which a first party, i.e. bank, provides the electronic bill payment service for a fee to its customers (column 9, lines 25-44, "1. The opportunity to provide a new service for a fee ... can themselves operate as Payer's bank."). The bill payment service of Perazza ('959) requires that the bank collect the necessary payment information from its customers. Once the necessary information has been obtained, the bank would periodically generate a document for each customer with an with various preprinted indicia on the document. The preprinted indicia include identifying indicia for the payer and payee as well as the transaction data to indicate the amount to be paid to a payee, i.e. second party. After the bank receives the document, the bank processes the document by scanning the document and then causing the amounts specified in the transaction data to be paid to the second party. It is noted further noted that since the bank charges a fee for the bill paying service, the generation of the document inherently indicates proof of payment for the bill paying service.

8. The following is an Examiner's Statement of Reasons for Allowance over the prior art:

A) the prior art, for example, Taylor et al (4,812,994) which disclose the use of passwords entered by the user to determine whether or not an user may operate a postage meter to dispense postage or perform any other postage metering function.

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B) however, in regard to claims 26 & 130, the prior art does not teach or suggest the use of mail content data, e.g. sender information, to determine whether or not an user may operate a postage meter to dispense postage or perform any other postage metering function. Claims 27, 28, 33-35, 131 & 134-138 are allowable for the same reason.

C) however, in regard to claim 192, the prior art does not teach or suggest the use of a postage indicia to cause to the postal carrier to provide an advance message concerning the content of an item of mail to another party. Claims 193-200, 205 & 210 are allowable for the same reason.

8.1 In regard to claims 44, 68, 147 & 171, the prior art does not teach or suggest including a confirmation request in the instructions included in the transaction data.

8.2 In regard to claims 46, 71, 149 & 173, the prior art does not teach or suggest including a digital signature in the indicia.

8.3 In regard to claims 52, 77, 155 & 179, the prior art does not teach or suggest that the first party is the postal authority.

8.4 In regard to claims 60 & 163, the prior art does not teach or suggest that the first party causes the mail piece to be delivered.

8.4 In regard to claims 201-204, the prior art does not teach or suggest including a postage amount in the indicia.

9. Response to applicant's arguments.

9.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.

10. The examiner has cited prior art of interest, for example:

A) the Managing Office Technology article, which discloses that a postage indicia contains proof of payment for a service.

B) Critelli (6,260,023), which discloses that a postage indicia contains proof of payment for a service and may contain other non-postage related information.

C) Linchan (6,327,578), which discloses a computer payment system that generates a token/indicia where the token causes the processor of the token to pay the amount specified in the token to another party.

D) Antognini et al (2002/00230555), which discloses a computer payment system that generates a document that contains an indicia with the information necessary to cause the processor of the token to pay the amount specified in the document to another party.

11. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

- 12.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.
- 12.2 The fax phone number for OFFICIAL FAXES is (703) 305-7687.
- 12.3 The fax phone number for AFTER FINAL FAXES is (703) 308-3691.

06/05/02


Edward R. Cosimano
Primary Examiner A.U. 3629